TRADE MARKS ACT 1994
AND THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 1996

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 722469
AND THE REQUEST BY SCHINDLER AUFZUGE AG
TO PROTECT A TRADE MARK IN CLASSES 7, 9 AND 37

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1. On 9 December 1999, Schindler Aufzuge AG of 13 Zugerstrasse, CH-6030 Ebikon, Switzerland, on the basis of International Registration no. 722469, requested protection in the UK under the provisions of the Madrid Protocol of the mark SMARTLIFT. Protection is sought for goods and services in classes 7, 9 and 37 as follows:

Class 7 - Lifts and goods lifts.

Class 9 - Electronic and electrical measuring and controlling components for lifts and goods lifts.

Class 37 - Installing, servicing and repairing lifts and goods lifts.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996, and Notice of Refusal under Article 9(3) was given because the mark is excluded from registration by Sections 3(1)(b) & (c) of the Trade Marks Act 1994. This is because the mark consists of the words "Smart" and "Lift" conjoined, which is a sign devoid of any distinctive character and may be serve in trade to designate the goods and services provided in relation to elevators which are brisk or operated by using automatic computer control.

3. Objection was also taken under Section 5(2) of the Trade Marks Act, but this objection was subsequently waived in full and so I need make no further reference to it. At a hearing on 13 March 2001, and in subsequent correspondence, Mr Peters of Dr Walter Wolf and Co, the holders representatives, made submissions in support of the application. His points may be summarised as follows:

> 1. He explained that the as yet unused mark SMARTLIFT is one of a family of similar marks used by the applicant such as SMART MRL and SCHINDLER SMART MRL. Therefore, the word SMARTLIFT will not have any descriptive significance in the minds of the relevant consumers, who are now used to the word SMART appearing as part of the applicant's trade marks.
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> 2. The mark SMARTLIFT should be considered as a single word and not broken down into two separate words for the ease of analysis.
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> 3. The word SMART does not mean computer controlled, automated or anything similar. The word, he submitted, is a colloquial jargon term suggesting intelligence

capacity in an inanimate object not otherwise imbued with any inherent intelligence.

4. Mr Peters further submitted that the class 9 goods are not lifts as such but measuring and controlling components for lifts, and also the services in class 37 are installation, maintenance and repair services for which the term SMARTLIFT could not be a direct descriptor. Accordingly, he urged me to accept the mark for classes 9 and 37 even if I was minded to maintain the objection against the lifts themselves in class 7.

5. He submitted that the state of the register is such that marks of similar construction using the word SMART have been accepted by the Registrar in recent times.

4. Despite all of the submissions, I maintained the Section 3(1)(b) and (c) objections against all three classes and Notice of Refusal under Article 9(3) was issued on 2 October 2001. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the Grounds of Decision and materials used in arriving at it.

5. No evidence of use has been put before me. I have therefore only the prima facie case to consider.

6. Section 3(1)(b) & (c) of the Act reads as follows:

"The following shall not be registered"

(b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services".

7. The mark consists of the words SMART and LIFT conjoined. Both of these are well known words that appear in the Collins English Dictionary (5th Edition 2000). A particular meaning of the word "Smart" isgiven as "(of systems)operating as if by human intelligence by using automatic computer control".

8. Despite the agents assertions to the contrary, I am of the opinion that the mark as a totality, SMARTLIFT, conveys the message to the relevant consumers that when used in the context of the goods and services claimed, the products and associated services on offer are all concerned with lifts or elevators that are "smart" in the way described above. The concept of a lift that is "smart", or to use the dictionary definition, "operating as if by human intelligence by automatic computer control", is a perfectly feasible premise in my view. Rather than the user entering the lift and manually operating it by means of pressing buttons on the side to instruct the machine for the required operation, the lift could, for example, be adapted to operate by means of sound or movement rather than the pressing of buttons.

9. I am not persuaded by the agents later submissions to accept the mark only in class 9 for

the components, and in class 37 for the services. This would only take out the claim in class 7 for the lifts themselves. It seems to me that once one accepts the concept of a smart lift, then the components for its operation, and the installation and maintenance service in respect of such goods is all part of the business, and SMARTLIFT is merely a direct descriptor of the lifts themselves and the spare parts and services that is bound to accompany the core business of providing the lifts.

10. The agent's other submissions regarding the acceptance by the Registrar of other marks incorporating the word SMART are not persuasive. Each case must turn on its own facts, and certainly the applicant's other marks consist of the word SMART with other distinctive matter.
11. On 20 September 2001, the European Court of Justice issued a judgement in *Proctor & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

12. I give below paragraphs 37, 39 and 40 of the judgement in full:

> "37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."
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> "39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way or designating the goods or services concerned or their essential characteristics."
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> "40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

13. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I have already taken the view that the mark at issue comprises two highly descriptive words conjoined, and they are presented in a non-figurative manner.

Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods and services.

14. In reaching this conclusion I accept that the Registrar has not presented any evidence that the term SMART LIFT is already in normal usage. I do not believe that this is necessary. It is implicit from the words "may serve" that an element of futurity is to be considered. The dictionary meanings of the words concerned are sufficient to confirm that the mark consists exclusively of a natural way of designating a characteristic of the goods.

15. In this decision I have considered all documents filed by the agent, and for the reasons given it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 18TH day of January 2002.

Janet Folwell
For the Registrar
the Comptroller General